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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/805,914	03/22/2004	Neil Andrew Abercrombie Simpson	MRKS/0057.C1	2030

7590 03/31/2005

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EXAMINER

GAY, JENNIFER HAWKINS

ART UNIT

PAPER NUMBER

3672

DATE MAILED: 03/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/805,914	SIMPSON ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jennifer H Gay	3672	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☒ Responsive to communication(s) filed on 07 February 2005.

2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) 18-49 is/are pending in the application.

    4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) ☒ Claim(s) 18-38 is/are allowed.

6) ☒ Claim(s) 39-48 is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All    b) ☐ Some \* c) ☐ None of:

        1. ☐ Certified copies of the priority documents have been received.

        2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

        3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
    Paper No(s)/Mail Date \_\_\_\_\_

4) ☐ Interview Summary (PTO-413)  
    Paper No(s)/Mail Date. \_\_\_\_\_

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 39-48 are rejected under 35 U.S.C. 102(e) as being anticipated by Gano et al. (US 6,568,472).

*Regarding claim 39:* Gano et al. discloses a system for expanding a tubular 12.

The system includes the following features:

- An expander 38 that has an outer diameter larger than an inner diameter of the tubular 12 being expanded (Figure 2) where the tubular has a substantially continuous circumference.
- A seal 28 to create a fluid seal with an unexpanded portion of the tubular ahead of the expander.
- A lubricant 56 supplied to the inner diameter of the tubular and in fluid communication with at least a section of the outer diameter portion of the expander (Figure 2). The examiner notes that element 56 is not described as a lubricant but rather a wash fluid, however, any fluid forced between the seal and the expander would function as a lubricant.

*Regarding claims 40, 45:* Though not specifically disclosed or shown, the system must inherently include a lubricant supply in order to provide the lubricant downhole. Further, the fluid must be supplied continuously in order to be able to perform its disclosed function of preventing skin (4:5-45).

*Regarding claims 41, 46:* The lubricant is pressurized.

*Regarding claims 42, 47:* The lubricant is supplied to an interior of the tubular isolated by the seal and having the expander disposed therein (Figure 2).

*Regarding claims 43, 48:* The lubricant is pressurized within an interior of the tubular isolated by the seal and having the expander disposed therein.

*Regarding claim 44:* Gano et al. discloses the method for using the above system.

The method involves the following steps:

- Urging the expander against an inside surface of the tubular (Figure 2).
- Sealing an unexpanded portion of the tubular ahead of the expander.
- Supplying the lubricant to the inside surface of the tubular by directing the lubricant against the inside surface of the tubular where substantially all of the lubricant is forced between the expander and the inside surface of the tubular along a length of the expander in contact with the tubular (4:28-32).
- Expanding the tubular with the expander.

### ***Allowable Subject Matter***

3. Claims 18-38 are allowed.

### ***Response to Arguments***

4. In view of applicant's amendment, the objections to the specification and claim 24 have been withdrawn.

5. In view of the Terminal Disclaimer filed 07 February 2005, the double patenting rejection of claims 18-21 over US Patent No. 6,712,151 has been withdrawn.

6. Applicant has argued that with respect to independent claim 22 that the sand screen of Gano et al. is incapable of providing a substantially sealed fluid volume in an interior section of

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an unexpanded portion of the screen as the screen is porous thus cannot hold fluid. The examiner has reviewed claim 22 and the Gano et al. reference and agrees with this argument. The 35 USC 102(e) rejection of claims 22-38 has been withdrawn.

7. Applicant's arguments filed 07 February 2005 have been fully considered but they are not persuasive.

Applicant has argued with respect to independent claim 39 that sand screen of Gano et al. does not have a substantially continuous circumference due to the perforations formed in the screen. While the examiner acknowledges that the wellbore tubular of Gano et al. is a sand screen that contains a plurality of perforations, i.e. not a solid tubular, the general circumference of the tubular is still considered to be continuous. Circumference<sup>1</sup> is defined as the boundary line of a circle and the perforations of the screen would not affect a boundary line drawn around the screen of Gano et al. It is the opinion of the examiner that a substantially continuous circumference is defined by the outer diameter of a tubular and the outer diameter of a sand screen is considered to be constant.

Applicant has argued with respect to independent claim 44 that only a portion of the wash fluid disclosed by Gano et al. flows along a length of the expander within the grooves thus does not teach the limitation of substantially all of the lubricant being forced between the expander and the inside surface of the tubular along a length of the expander in contact with the tubular. While the examiner acknowledges that the wash fluid does flow along the grooves in the disclosed expander, Gano et al. also teaches that the washing fluid flows through the grooves of the expander where the expander is in contact with the inner surface of the tubular (4:28-32). Thus Gano et al. teaches substantially all

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<sup>1</sup> **cir-cum-fer-ence** (ser-kûm'fer-ens) *noun*

*Abbr. cir, circ., circum.*

1. The boundary line of a circle.

2. a. The boundary line of a figure, area, or object. b. The length of such a boundary.

of the washing fluid, or lubricant, being forced between the expander and the inside surface of the tubular.

### ***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer H Gay whose telephone number is (703) 308-2881. The examiner can normally be reached on Monday-Thursday, 6:30-4:00 and Friday, 6:30-1:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on (703) 308-2151. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

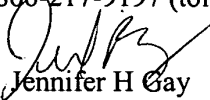
As applicant may be aware, the USPTO is in the process of moving to a new, consolidated campus. The examiner is currently still located at the old campus and can be reached at the above phone number. However, starting on 31 March 2005 all calls to the examiner should be made using a new telephone number, which is (571) 272-7029. Starting on that date, David Bagnell can be reached at (571) 272-6999. Please note that the official fax number will not be changing.


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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Jennifer H. Gay  
Patent Examiner  
Art Unit 3672

JHG   
March 21, 2005